

## **REMARKS**

The application included claims 1-10, 12-24, and 31 prior to entering this response.

Claims 3 and 6 were indicated as including allowable subject matter

The Applicant amends claims 1, 2, 4, 5, 7, 8, 15, and 19. No new matter is added.

The application remains with claims 1-10, 12-24, and 31 after entering this response.

### **Applicant Comments on the Examiner's Response to Amendment**

In view of Applicant's prior arguments, the Examiner withdrew the rejection of claims 1-10, 12-24, and 31 under 35 U.S.C. § 112 (page 2, section 2 (1) of the September 20, 2011 Office Action). Applicant thanks the Examiner for his additional consideration.

Additionally, the Examiner stated that "Applicant's arguments filed 7/6/2011 and 2/16/2011, with respect to the rejection of claims 1, 2, 4-5, 7-10, 12-24 and 31 under 35 U.S.C. 103(a) have been fully considered but are not persuasive" (page 2, section 2 (2) of the September 20, 2011 Office Action). Applicant respectfully disagrees, and wishes to clarify the prosecution history.

Claims 1, 4, 7, and 31 are presently rejected under 35 U.S.C. 103(a) over the reference to Su in view of Maeda *et al.* and Irving *et al.* (page 4, section 4 of the September 20, 2011 Office Action). Applicant notes that this is the first time that Maeda has been used to reject claims 1, 4, 7, and 31, and it appears to be the first time that Maeda has been referenced during the entire prosecution history of the subject application. Accordingly, Applicant respectfully submits that Applicant's previous arguments filed February 16, 2011 and July 6, 2011 in fact appears to have been persuasive since the Examiner issued yet a further non-final Office Action including new grounds of rejection. In any event, the Examiner has not provided any other explanation for changing the grounds of rejection of these, or other, claims, over the newly cited reference to Maeda.

### **Subject Matter Indicated as Allowable**

The Examiner objected to claims 3 and 6 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form. Applicant thanks the Examiner for the indication of allowable subject matter and the proposed amendment.

While Applicant appreciates that the Examiner has indicated that these claims are allowable, Applicant respectfully declines to rewrite claims 3 and 6 in independent form on the basis that the independent claims 1 and 4, upon which they depend, are themselves allowable, as discussed further below.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 1, 2, 4, 5, 7-9, and 31 under 35 U.S.C. § 103(a) over Su (U.S. Patent 6,233,011) and variously in view of Maeda *et al.* (U.S. Patent 5,515,180), Irving *et al.* (U.S. Patent 6,658,164), Lee *et al.* (U.S. Patent 6,178,015), and Rykowski *et al.* (U.S. Patent 6,975,775).

The rejection is traversed; however, Applicant amends claims 1, 2, 4, 5, 7, and 8 only to expedite prosecution, and without prejudice to pursuing the claims as previously presented or in other forms. Amended claim 1 recites, in part, a method comprising:

scanning, with a scanning element of the scanner, a document to determine a plurality of actual gray level values for a plurality of pixels scanned from the document, wherein the scanning element is configured to scan the document along a scanning path associated with the scanner;  
scanning, with the scanning element, a continuous longitudinal calibration pattern while scanning the document to determine a correctional gray level value associated with the calibration pattern, wherein the scanning element is configured to concurrently scan both the calibration pattern and the document at multiple positions along the scanning path.

In rejecting claim 1, the Examiner acknowledged that Su fails to disclose “scanning a calibration pattern while scanning the document” and instead alleged that these features are disclosed by Maeda (page 5, final two paragraphs of the September 20, 2011 Office Action).

Specifically, the Examiner identified column 21, line 65 to column 22, line 12 of Maeda, which references FIG. 38 illustrating “a reference white document 80 placed at an end portion of the transparent glass plate 15 (where this) reference white document is every time scanned together with the original to be printed” (col. 22, lines 10-15).

Applicant appreciates that the Examiner may examine the recited features according to the broadest reasonable interpretation. Only to expedite prosecution, Applicant amends claim 1 to clarify the recited terms. For example, claim 1 is amended to recite *wherein the scanning element is configured to concurrently scan both the calibration pattern and the document at*

*multiple positions along the scanning path.* The recited features are believed to be both novel and non-obvious in view of the combination.

Although of different scope than claim 1, independent claims 4 and 7 recite certain features similar to those discussed above in claim 1, such that the comments directed to claim 1 also apply to claims 4 and 7. As claims 2, 5, 8, 9, and 31 depend directly or indirectly from independent claims 1, 4 or 7, the comments and revisions directed above to claims 1, 4, and 7 apply equally to claims 2, 5, 8, 9, and/or 31, respectively. In addition, claims 2, 5, 8, 9, and 31 recite further subject matter. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, 4, 5, 7-9, and 31 is respectfully requested.

The Examiner rejected claims 10, and 12-24 under 35 U.S.C. § 103(a) over Liu (U.S. Patent 7,492,488) in view of Irving and Su.

The rejection is traversed.

In rejecting claim 10, the Examiner alleged that “Su teaches determining a correctional gray level value based at least in part on a scanned image of the reference pattern, wherein the reference pattern and the document are scanned at the same time” (page 14, final paragraph, of the September 20, 2011 Office Action). Applicant respectfully disagrees for similar reasons as previously provided in the response dated February 16, 2011. Furthermore, as discussed above, the Examiner himself has acknowledged that Su fails to disclose “scanning a calibration pattern while scanning the document” (page 5, next to last paragraph of the September 20, 2011 Office Action).

Whereas Su describes that the pixels of the image are scanned and the resulting gray-scale values are output while reading the image (col. 4, lines 34-39), both the image and the corresponding pixels are nevertheless scanned after the white plate has already been scanned to determine the average value  $G'(X)$  used for gray level compensation (col. 2, lines 4-20 and col. 4, line 20-24). Accordingly, the combination fails to disclose all of the features recited by claim 10.

In rejecting claim 19, the Examiner stated that “claim 19 is rejected for the same reason discussed in claim 1 above” (page 20 of the September 20, 2011 Office Action). Applicant respectfully submits that claim 19 recites means plus function under 35 U.S.C. § 112, paragraph 6

and that the Examiner has failed to examine the claim according to the USPTO's own guidelines (MPEP 2181).

Although of different scope than claim 10, independent claim 19 recites certain features similar to those discussed above in claim 10, such that the comments directed to claim 10 also apply to claim 19. As claims 12-18 and 20-24 depend directly or indirectly from independent claims 10 or 19, the comments and revisions directed above to claims 10 and 19 apply equally to claims 12-18 and/or 20-24, respectively. In addition, claims 12-18 and 20-24 recite further subject matter. For example, previously presented claim 20 recites, in part, *wherein the means for scanning is further configured to continuously scan both the calibration pattern and the document while moving longitudinally along the scanning path*.

As discussed above, Su teaches that the image is scanned after the white plate has already been scanned (col. 2, lines 4-20 and col. 4, line 20-24). Even assuming, arguendo, that Su discloses that the image is continuously scanned along a scanning path, Applicant respectfully submits that Su fails to disclose that both the image and the white plate are continuously scanned along a scanning path. Rather, one of ordinary skill in the art would assume that Su's white plate is positioned at one end of the scanner like other conventional scanners.

Accordingly, reconsideration and withdrawal of the rejection of claims 2 and 12-24 is respectfully requested.

Any statements made by the Examiner that are not addressed by the Applicant do not necessarily constitute agreement by the Applicant. In some cases, the Applicant may have amended or argued the independent claims thereby obviating grounds for rejection of the dependent claims. Additionally, any arguments made in a prior response that may not have again been raised in the present response are not deemed to have been waived, and may be reasserted by Applicant in a future response or Appeal Brief, as applicable.

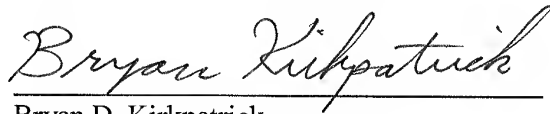
### CONCLUSION

For the foregoing reasons, the Applicant respectfully requests reconsideration and allowance of the present application. The Examiner is encouraged to telephone the undersigned at (503) 546-1812 if it appears that an interview would be helpful in advancing the case.

**Customer No. 73552**

Respectfully submitted,

STOLOWITZ FORD COWGER LLP

A handwritten signature in cursive script, reading "Bryan Kirkpatrick", written over a horizontal line.

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